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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,404	10/16/2001	Michiaki Yokoyama	1341.1112	3181

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,404

Applicant(s)

YOKOYAMA ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second transmitting unit, and order and purchase accepting unit (both cl. 6), incentive giving unit (cl. 7); must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because the meaning of "introduction source entry" is unclear.

Claim 1 is further indefinite because in line 13, it is unclear what "introduction goods and a service" are.

Claim 1 is further indefinite because it is unclear what "transmitting, to the terminal of the existing customer, ... an introduction mail ... from the terminal of the existing customer to a terminal of an introduced person and is to be transferred from the terminal of the existing customer to the terminal of the introduced person"

Claim 1 is further indefinite because in line 20, "transmitting the introduction request" is unclear. As understood by the examiner, a second introduction request would be sent.

Claims 5 and 6 are indefinite because the meaning of "introduction source entry" is unclear.

Claim 5 is further indefinite because it is unclear what "introduction goods and a service" are.

Claim 5 is further indefinite because it is unclear what "transmitting, to the terminal of the existing customer, an introduction mail ... from the terminal of the existing customer to a terminal of an introduced person and is to be transferred from the terminal of the existing customer to the terminal of the introduced person"

Claims 5 and 6 are further indefinite because, "transmitting the introduction request" is unclear. As understood by the examiner, a second introduction request would be sent.

Claim 6 is indefinite because the preamble recites an apparatus. The body of the claim recites several units. If these are interpreted as being apparatus, they do not appear to be shown. If they are intended to be software modules, it would be helpful if they were to be positively claimed as such. Presently, it is not clear what is being claimed.

Claim 7 is indefinite for the same reasoning as claim 6 above.

Claim 8 is indefinite because the body appears to recite only a method step which is not limiting on the apparatus.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 6 recites a second transmitting unit which transmits an introduction email. However, the specification does not appear to describe or enable an apparatus having a second transmitting unit. Rather it appears that all messages leaving the server go through the transmitting unit 104. One of ordinary skill in the art would not have been able to make or use the invention as claimed without undue experimentation.

Claim 6 is further indefinite because it is unclear what "transmits, to the terminal of the existing customer, an introduction mail ... from the terminal of the existing customer to a terminal of an introduced person and is to be transferred from the terminal of the existing customer to the terminal of the introduced person"

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Mullaney (2001/00037283).

Mullaney discloses a computer readable medium capable of storing instruction affecting all claimed steps. (it is noted that "for storing instructions" is interpreted as intended use only and that all further recitations only further elaborate on the instructions and place no further limitations on the computer readable medium).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney.

As to claims 1 and 5, Mullaney shows transmitting an introduction request email to an existing customer terminal, the email comprising an email introducing new services to the existing customer. The email is further related to a new customer introduction since it relays the existing customer to a web page for providing customer referrals (e.g., Fig. 4). Mullaney further shows accepting introduction source entry from the existing customer (e.g., Fig. 4); transmitting an introduction mail which includes a message for introduction of goods and services for receipt at a terminal of an introduced person. Mullaney inherently shows accepting an order and purchase of the goods and

services since it shows accepting orders and purchases and is soliciting that person for the reason of accepting the order and purchase. Mullaney inherently shows transmitting a second introduction request email since it shows transmitting the emails to clients (existing customers) and once the introduced person has made a purchase, he is a client. Mullaney does not show sending the introduction email to the person to be introduced by having the existing customer forward it. However, it is notoriously old and well known to provide solicitations and emails for forwarding. It would have been obvious to one of ordinary skill in the art to modify the method of Mullaney by doing so in order to encourage the introduced person to read it due to the familiarity of the sender.

As to claim 6, it is noted that Mullaney in view of the well known prior art shows all recited functional units, the functional units accomplishing the steps of the method of claim 1.

As to claims 2 and 7, Mullaney shows providing an incentive.

As to claims 3 and 8, Mullaney does not show selecting an address from the address book for performing the transfer. However, to use an address book to retrieve an email address for sending or forwarding an email is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Mullaney by selecting the address from an address book in order to avoid errors in transcription.

As to claims 4 and 9, Mullaney does not show requiring the introduced person to provide information about the existing customer at the order step. However, it is

notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to require the introduced person to provide information, such as a name, of the existing customer in order to facilitate provide the incentive to the existing customer.

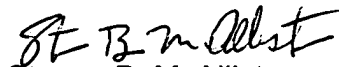
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER